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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,156	07/18/2005	Heiner Sann	08146.0007U1	8087
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NEEDLE & ROSENBERG, P.C. SUITE 1000 999 PEACHTREE STREET ATLANTA, GA 30309-3915			EXAMINER SCHNEIDER, CRAIG M	
			ART UNIT	PAPER NUMBER
			3753	
			MAIL DATE	DELIVERY MODE
			05/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/530,156

Applicant(s)

SANN ET AL.

Examiner

Craig M. Schneider

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/1/05 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 7/18/05.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because Figures 1 and 2 do not clearly show the intended structure. Please submit drawings that do not include the solid black shading, which is not permitted per 37 CFR 1.84(m). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because Figures 3 and 4 are not in English. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement

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drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: It is noted that the applicant is referring to claims 1 and 15 in multiple places in the specification. This is not recommended because the meaning of the claims can change during the prosecution of the case and it is recommended to remove the references to the claims as seen on pages 1 and 3.

On page 4, line 17 "be" should be --being--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 15 both recite a broad recitation "liquid samples from container and/or tubes", and then recites "in particular from fermenters" which is a narrower statement of the range/limitation. It is unclear if "from fermenters" is merely exemplary, and therefore not required, or a required features of the claims.
6. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).
7. Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. The recitation "the container" is indefinite because it is unclear as to which container the applicant is referring to, the one containing rinsing liquid or the one that the liquid samples are being extracted from. Claim 12 is further indefinite because it is unclear what is connected to the container, a rinsing liquid supply connection or a gas and rinsing liquid connecting line and where is the sterile filter located. Claim 13 is further indefinite because it is unclear what is connected to the container, a gas supply connection or a gas and rinsing liquid connecting line and where is the sterile filter located.

8. Claims 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because the preamble of the claims state that the claims are directed to a method but the body of the claims do not define a step to take for a method therefore it is unclear if this is a method or an apparatus claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4, 9, and 14 are rejected as understood under 35 U.S.C. 102(b) as being anticipated by Endo et al. (4,501,161).

Endo et al. disclose a device for extracting liquid samples from containers and/or tubes filled with a medium, in particular from fermenters, via a filter membrane by means of a partial vacuum, characterized in that the filter membrane (11 and 11') arranged within a sample probe comprises a material acting as a sterile boundary, whereby a supply line (4) which can be used to guide gas and a discharge line (4') which can be used to guide the sample are arranged on the sterile boundary side of the filter membrane (col. 2, line 12 to col. 3, line 13).

Regarding claim 14, wherein the discharge line is connected to a device (5) acting as a valve.

11. Claims 1-5, 9, and 14-15 are rejected as understood under 35 U.S.C. 102(b) as being anticipated by Kenkyusho et al. (JP60219539).

Kenkyusho et al. disclose a device for extracting liquid samples from containers and/or tubes filled with a medium, in particular from fermenters, via a filter membrane by means of a partial vacuum, characterized in that the filter membrane (4) arranged within a sample probe comprises a material acting as a sterile boundary, whereby a supply line (7) which can be used to guide gas and a discharge line (8) which can be used to guide the sample are arranged on the sterile boundary side of the filter membrane (abstract).

Regarding claim 5, the device characterized in that the supply line (7) which is able to guide gas is connected to a first gas-bearing connecting line (9 to 11) to connect the supply line (7) to a gas supply connection (area before 11).

Regarding claim 14, wherein the discharge line is connected to a device (13) acting as a valve.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 6 is rejected as understood under 35 U.S.C. 103(a) as being unpatentable over Kenkyusho et al.

Kenkyusho et al. discloses that a valve (9) is arranged in the area of the first end of the connecting line. Kenkyusho et al. does not disclose that a second valve is arranged in the second end of the connect ling line.

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The examiner takes official notice that putting a second valve in a line is old and well known in the art and would be combined with the device of Kenkyusho et al. for reasons that are old and well known in the art.

15. Claim 7 and 18 are rejected as understood under 35 U.S.C. 103(a) as being unpatentable over Kenkyusho et al. in view of Burch (5,316,181).

Kenkyusho et al. disclose all the features of the claimed invention except that a pressure sensor is arranged in the gas-bearing connecting line. Burch discloses using a pressure sensor (46) in a system (col. 6, lines 29-30).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the pressure sensor of Burch in the gas supply line of Kenkyusho et al., in order to sense the pressure.

16. Claim 8 is rejected as understood under 35 U.S.C. 103(a) as being unpatentable over Kenkyusho et al. in view of Froelich (3,428,413).

Kenkyusho et al. disclose all the features of the claimed invention except that the gas bearing line contains a sterile filter. Froelich discloses using a sterile air filter (26) in a gas line (col. 3, lines 36-42).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the sterile filter of Froelich onto the gas line of Kenkyusho et al., in order to eliminate the germs.

17. Claims 10-11 and 16-17 are rejected as understood under 35 U.S.C. 103(a) as being unpatentable over Kenkyusho et al. in view of Furness (5,636,763).

Kenkyusho et al. disclose all the features of the claimed invention except that the supply line is connected to a second rinsing liquid-bearing connecting line. Furness discloses using a water flush mode to clean the system as seen in Figure 6 (col. 11, lines 4-8).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the flush mode of Furness onto the system of Kenkyusho et al, in order to flush the system of unwanted material.

Regarding claim 11, wherein the rinsing liquid bearing line is connected to a container (51 in Furness) containing a rinsing liquid.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Liedtke (6,460,730) discloses a filter in the flow path from a tank. Kao et al. (5,857,590) disclose pressurized fluid discharge.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig M. Schneider whose telephone number is (571) 272-3607. The examiner can normally be reached on M-F 8:30 -5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Keasel can be reached on (571) 272-4929. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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